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10/666,777	09/18/2003	Dietmar Schatkowski	3968.091	9437

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Pendorf & Cutliff
5111 Memorial Highway
Tampa, FL 33634-7356

EXAMINER

SHIPPEN, MICHAEL L

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,777

Applicant(s)

SCHATKOWSKI ET AL.

Examiner

MICHAEL L. SHIPPEN

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102¹

Claims 1-10, 15 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,252,986, USP 4,623,750 or SU 1,082,780. Note the third stage of Example 1 of USP 4,252,986; Example 2B of USP 4,623,750 and the example of SU 1,082,780 as described in the abstract provided. While some of the references may not recite the trans isomer being present, the isomer is inherent in the product mixture. Moreover, the process steps of the prior art anticipate the claimed process steps regardless of the manner the product is characterized in the prior art.

Claim Rejections - 35 USC § 103²

Claims 1-12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,252,986, USP 4,623,750 and SU 1,082,780. The references are applied as above. To the extent the references do not anticipate the claims, the references differ from the claimed invention as to specific reactants and/or recited

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

² The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

reaction conditions. The claimed reactants are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious. It is well within the skill of the artisan to operate within the parameters suggested by the disclosure of the reference and carry out the prior art process with the expectation that one will obtain the results taught in the reference. The optimization of reaction conditions for a particular reaction system to optimize a result (such as to maximize the yield of a desired product) is well within the skill of the artisan through routine experimentation, *In re Aller*, 105 USPQ 233.

Claim Rejections - 35 USC § 112³

Claims 11, 12, and 14 are rejected under 35 USC 112, second paragraph, as failing to particularly point out the claimed invention. The expressions "said Raney

³ The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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nickel" or "said base" do not have antecedent basis in parent claim 8 rendering the claims indefinite as to what is actually being referred to.

Allowable Subject Matter


Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The remaining references are cited as of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
August 20, 2004


MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621